* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% Judgment reserved on: 19.05.2026
Judgment delivered on: 19.06.2026

\+ C.O. (COMM.IPD-TM) 215/2023 & I.A. 18072/2023

HONASA CONSUMER LTD .....Petitioner

versus

VISAGE BEAUTY AND HEALTH CARE PVT LTD & ANR.
.....Respondents

Advocates who appeared in this case:

For the Petitioner : Mr. Abhimanyu Bhandari, Senior Advocate alongwith Ms. Kartika Sharma, Ms. Harsha Sandhwani, Mr. Sahil Saraswat, Mr. Manav Mitra and Ms. Shubhika Joshi, Advocates.

For the Respondents : Mr. Vaibhav Vutts, Ms. Aamna Hasan, Ms. Anupriya Shyam, Mr. Aarya Deshmukh and Ms. Vaibhavi SG, Advocates for R-1.
Mr. Vikrant Nilesh Goyal, Mr. Mohit Goyal, Mr. Yash Basoya, Mr. Inderpreet Singh and Mr. Kunal Dixit, Advocates for R-2.

CORAM:
HON'BLE MR. JUSTICE TUSHAR RAO GEDELA

J U D G M E N T

TUSHAR RAO GEDELA, J.

1. The present petition has been filed under Section 57 of the Trade Mark Act, 1999 (hereinafter referred to as '*the Act*') seeking rectification of the trademark 'D-TAN' bearing registration no.2065580 in Class-3 granted in favour of respondent no.1.

2. The facts, in brief, as stated by the petitioner are that the petitioner company was incorporated in the year 2016. It is stated that the respondent no.1 filed the Trade Mark Application bearing no.2065580 in Class-3 for the mark 'D-TAN' on 09.12.2010 which was advertised in the Trade Marks Journal bearing no.1814-0 on 11.09.2017. On 30.01.2018, the Trade Mark Application of respondent no.1 proceeded for registration.

3. The petitioner claims to have launched its products under the trademark 'AQUALOGICA' in the year 2021. While the petitioner was manufacturing and offering for sale its products under the mark 'AQUALOGICA', on 14.04.2023 the respondent no.1 is alleged to have issued a cease and desist notice alleging infringement of its trademark 'D-TAN' by the petitioner's product under the mark 'AQUALOGICA DETAN + DEWY SUNSCREEN' on the ground that the mark used by the petitioner is deceptively similar to the mark 'D-TAN'.

4. *Vide* the communication dated 05.05.2023 the petitioner claims to have responded to the cease and desist notice of the respondent no.1 refuting the claims and contentions contained in the cease and desist notice. The petitioner, in its reply dated 05.05.2023, mentioned that the notice of infringement issued by the respondent no.1 is misconceived and bereft of merit, inasmuch as the mark 'D-TAN' is a descriptive term, commonly used in the trade to denote the process of removing tanned skin, and is therefore not eligible for trademark protection. The petitioner also mentioned in the said reply that the use of the mark by the petitioner is honest and concurrent, and has been so used since 2016, thereby entitling it to protection under Section 12 of the Act. Furthermore, the petitioner mentioned in the said reply that the respondent

no.1 has failed to demonstrate any likelihood of confusion or deception, and that the instant proceedings are an attempt to stifle legitimate competition. The petitioner in the said reply also places reliance on the widespread use of the term 'DETAN' by multiple brands and products in the market, as evidenced by Google search results, to demonstrate that the term has become generic and is not distinctive of the petitioner's goods. Thereafter, a reminder dated 08.05.2023 was received by the petitioner in respect of the aforesaid notice.

5. Aggrieved by the action initiated by the respondent no.1, the petitioner filed the present rectification petition.

ARGUMENTS OF PETITIONER:-

6. Mr. Abhimanyu Bhandari, learned senior counsel appearing for the petitioner argued as under:

6.1. At the outset, learned senior counsel would contend that the impugned mark 'D-TAN' is descriptive apart from being devoid of any distinctive character and is common to trade, thus, not registrable. He would contend that the mark being purely descriptive lacks distinctive character and as such, the registration itself is in clear violation of Section 9(1)(c) of the Act. It was contended that Section 9(1)(c) of the Act specifically prohibits registration of marks that are devoid of distinctive character and are incapable of distinguishing the goods of one person from those of another. His contention was that the term 'D-TAN' unequivocally describes the quality and the intended purpose of the goods.

6.2. Dilating further, learned senior counsel contended that in common parlance, the term 'D-TAN' would simply imply removal of the tanning of the skin. Thus, according to him, any product which purports to remove tanning

of the skin or the face would ordinarily be described as a 'de-tan' product. He would also contend that this term is widely and commonly used in the cosmetics industry across the world. As an example, learned senior counsel would contend that in the cosmetics and beauty industry, phrases like hydrating, exfoliating, de-tan are used to describe the type and nature of the products which cannot be monopolized.

6.3. Yet another argument in continuation of the aforesaid submission was that a trademark would not be refused registration if (i) the mark has acquired distinctiveness through use and (ii) the mark has come to be exclusively associated in the public mind with the proprietor's goods and/or services. According to him, the impugned mark of respondent no.1 does not satisfy either of the limbs of proviso to Section 9(1) of the Act. To demonstrate the said submission, the petitioner has placed on record large volumes of third party use of the word 'DETAN' and its variants as well as multiple third party registration in Class-3. According to him, the aforesaid documents and registrations are a clear indicator that all the relevant stakeholders in the cosmetics industry manufacturing cosmetics and skin care products understand and use the word 'DETAN' as a descriptive word simply to describe the product. He places reliance on the following judgments:

(1) ***Delhivery Private Limited vs. Treasure Vase Ventures Pvt. Ltd., 2020 OnLine Del 2766*** (paras 69 and 75);

(2) ***Cadila Health Care Ltd. vs. Gujarat Cooperative Milk Marketing Federation Ltd., 2018 SCC OnLine Bom 4789*** (paras 8 to 11 and 13);

(3) ***Pornsricharoenpun Co. Ltd. and Anr. vs. L'oreal India Pvt. Ltd. and Anr. , 2022 SCC OnLine Del 3826*** (paras 13 and 21);

(4) ***Anil Verma vs. R.K. Jewellers SK Group, 2019 SCC OnLine Del 8252*** (paras 22 to 25).

6.4. The other limb of the argument canvassed by Mr. Bhandari, learned senior counsel for the petitioner, is in respect of a purported fraud played by the respondent no.1 upon respondent no.2/Registrar of Trade Marks by getting a generic and descriptive term registered as a trademark. In order to demonstrate the said contention, learned counsel referred to the screenshots of the website of the respondent no.1 to contend that the respondent no.1 uses as a dominant feature of its mark the word 'PROFESSIONAL O3+' and not 'D-TAN' which makes it clear that even the respondent no.1 uses the mark 'D-TAN' as a mere descriptor rather than a trademark. In this context, learned senior counsel relies on the judgment of this Court in ***Marico Ltd. vs. Agro Tech Foods Ltd.*, *2010 SCC OnLine Del 3806*,** particularly paras 10 and 15.

6.5. Learned senior counsel contended that even if it is assumed without admitting that the impugned mark is registrable, the petitioner has not infringed the mark 'D-TAN' of the respondent no.1. The said submission is predicated on the contention that the registration of a descriptive mark, 'D-TAN' in the present case, does not confer any exclusive right in the registered proprietor nor does it bar others in the trade from bonafide use of such mark as recognised in Sections 28, 30(2) and 35 of the Act. Learned senior counsel relies on Sections 30(2) and 35 of the Act, which according to him, provide that where a mark is descriptive of the nature, kind and intended purpose, character or quality of goods, in such cases the registered proprietor cannot restrain others from using the same. In the aforesaid context, he relies on the judgment in the case of ***Delhivery Private Limited vs. Treasure Vase***

Ventures Private Limited, ***2020 SCC OnLine Del 2766*** particularly paras 69, 75, 76 and 81.

6.6. Learned senior counsel emphasized that, apart from the aforesaid legal impediments, there is no similarity or deceptive similarity either in the trademarks of the trade dress or even the colour combination and the packaging of the products of both the parties. Referring to the photographs placed on record of the petitioner's products as also the respondent no.1's products, learned senior counsel submitted that while the trademark of the petitioner is 'AQUALOGICA', the trademark of respondent no.1 is 'D-TAN'. Another distinguishing feature, according to him, is the fact that the respondent no.1 itself prominently uses the the mark/name 'PROFESSIONAL O3+' apparently as its trademark and the mark 'D-TAN' is used on the packaging in a small and insignificant manner and more as a descriptor of a product. He urged that the colour combination and the packaging of the products of both the parties are completely different. He would also submit that the petitioner's 'AQUALOGICA DETAN' product range consists of face-wash, face serum and a sunscreen, whereas the product of respondent is primarily a face pack.

6.7. Learned senior counsel stated that the present petition under Section 57 of the Act on behalf of the petitioner is maintainable inasmuch as petitioner would fall within the ambit of the definition of "*an aggrieved person*" as stipulated in the said Section. He would submit that the respondent no.1 has, by issuing the cease and desist notice dated 14.04.2023, made some baseless and false allegations with the demand that the petitioner refrains from using the mark 'DETAN'. He would contend that in case the respondent no.1

succeeds in retention of the mark 'D-TAN' in the Register of Trade Marks, the petitioner would be adversely impacted and thus, would be an "*aggrieved person*" as defined in Section 57 of the Act. He relied upon the judgment of the Supreme Court in ***Hardie Trading Ltd. vs. Addison's Paint and Chemicals Ltd., 2003 (11) SCC 92*** particularly para 32 in support of his contention.

6.8. Learned senior counsel sums up his arguments by referring to Section 57(2) of the Act which provides rectification of a mark which has been entered without sufficient cause or is wrongly remaining on the Register of Trade Marks. According to him, the case squarely falls within the category of a mark 'wrongly remaining on the register'. In support of the aforesaid submission, he would contend that as the impugned mark is non-distinctive, descriptive and common to trade, the registration itself is in violation of provisions of Section 9 of the Act. For the said proposition, he relied on ***Bennet, Coleman & Company Limited versus Vnow Technologies Pvt. Ltd. & Anr., 2023 SCC OnLine Delhi 864*** (para 31) in support of his aforementioned contention.

ARGUMENTS OF THE RESPONDENT NO.1:-

7. On behalf of the respondent no.1 Mr. Vaibhav Vutts has argued as under:-

7.1. Giving the background of the respondent no.1, learned counsel states that it is a well-known beauty care company and its clients include some of the leading names in the beauty industry. In support of the said submission, it is stated that respondent no.1 has filed on record numerous documents to demonstrate accomplishments and accolades received by respondent no.1 in

relation to skincare and beauty products and services. Respondent no.1 is stated to be a proprietor of several marks including D-TAN, DE-TAN, D 10, O3+, AGELOCK, SARA, DERMAMELON, SHINE & GLOW etc.

7.2. Learned counsel would submit that the mark 'D-TAN' a unique, memorable and a catchy mark coined by the respondent no.1 in the year 2009. It is stated that the said mark does not find mention in the English language dictionary. It is emphasized that 'D-TAN' was adopted by respondent no.1 at a time when there was no person or entity using the said mark for the goods and services provided by respondent no.1. It is stated that from the year 2009 and for the last fifteen years, the respondent no.1 has regularly, extensively, openly and continuously been using the mark 'D-TAN' for its goods and services which has resulted in substantial and immense reputation in the said mark. It is stated that the sales of the products under the mark 'D-TAN' have been steadily increasing from Rs.13,25,898/- in FY 2009-10 to about Rs.51.8 Crores in FY 2023-24. In support thereof, the learned counsel for respondent no.1 would submit that the sales invoices and Chartered Accountant (hereinafter referred to as "*CA*") certificate has been filed and is relied upon.

7.3. Equally, learned counsel would also submit that the respondent no.1 has spent crores of rupees for the promotion of its mark 'D-TAN' in support whereof, the CA certificate has also been annexed. So far as its visibility both in print media and social media platforms is concerned, learned counsel would submit that magazines like Femina, Cosmopolitan, Salon International, Bridal Asia, etc., do carry promotional material apart from the respondent popularizing its brand through its own website. That apart, learned counsel also submits that the products under the brand 'D-TAN' are available on third

party e-commerce platforms like Amazon, Nyka, Flipkart etc. Additionally, the respondent no.1's mark 'D-TAN' is claimed to be featuring prominently on social media platforms like Facebook, Instagram and X (formerly Twitter).

7.4. It was stated by learned counsel that after extensive use of the mark 'D-TAN' for about ten years, commencing from the year 2009, it started noticing an increase in the number of infringers and violators after 2020. Learned counsel asserts that this trend commenced only and only because the mark 'D-TAN' of the respondent no.1 had already become successful and popular by then. In other words, learned counsel emphasized that the third parties started capitalizing, though unlawfully, the brand value of its mark 'D-TAN' in various forms. Since then, learned counsel would submit that the respondent no.1 was ever vigilant in protecting its mark 'D-TAN' and in support thereof has placed on record at least ten Court actions and oppositions, including issuance of legal notices in order to protect its mark 'D-TAN'. Mr. Vutts, learned counsel stated that out of the aforesaid legal proceedings 23 parties have already given undertakings not to use the mark 'D-TAN'. His contention on the aforesaid narration is, that this Court would assume, apart from the documentary evidence placed on record, by assessing the number of legal proceedings and the undertaking given by third parties, the substantial and immense reputation that the mark 'D-TAN' has garnered so as to become a source identifier for the respondent no.1's goods or has come to be exclusively associated with it.

7.5. Defending the entry made in the Register of Trade Marks of its mark 'D-TAN', learned counsel would submit that such entry in the Register of Trade Marks is on account of sufficient cause for the following reasons:

(a) that the mark ‘D-TAN’ is unique, catchy and easy to remember.

(b) that the mark has no meaning in the English language.

(c) that the mark ‘D-TAN’ was examined substantively under the statutory proceedings. Though an objection was raised by the Trade Marks Registry under Section 9 of the Act, the respondent no.1 filed its response whereafter, the said mark was advertised in the Trade Marks Journal and subsequently registered. In other words, learned counsel would vehemently contend that the objections raised in the petition were already raised by the Trade Marks Registry, considered and thereafter, the mark ‘D-TAN’ was granted registration. Thus, according to him, the petitioners are bound by the principles of *res judicata* and cannot raise the same issue again.

7.6. Mr. Vutts, learned counsel forcefully contended that the mark ‘D-TAN’ is neither generic nor common to trade as contended by the petitioner. He would contend that the petitioner’s argument on this issue is baseless inasmuch as the petitioner has relied upon some screenshots of third party manufacturers who are using the mark ‘D-TAN’ in different variants but have entered the field more than ten years after the respondent no.1 had coined, adopted and commenced use of the mark ‘D-TAN’ on its products. Thus, according to learned counsel, a mark which was already registered and had garnered substantial goodwill and reputation cannot be said to be wrongly remaining on the Register of Trade Marks merely because the market is now flooded with other stakeholders who are new entrants into the said field of manufacture of skincare products. In addition, he would stoutly contend that as a matter of fact the respondent no.1 has not slept over its rights and has

from time to time taken recourse to legal remedies as available in law. Learned counsel would submit that it is settled that a proprietor of a mark is neither expected nor obligated to take action against all the third party infringers. In that context, he relies on the judgment of this Court in ***Pankaj Goel vs. Dabar India*** (***2008 SCC OnLine Del 1744*** in para 21-22); ***Under Armour Inc. vs. Aditya Birla Fashion & Retail Ltd.*** (***2023 SCC OnLine Del 2269*** in para 31-34).

7.7. Learned counsel asserts that the mark 'D-TAN' has always been used in all capital letters and prominently on the product packaging and thus, distinguishes it from the other contents of the product packaging. He would submit that respondent has and continues to claim rights in the mark 'D-TAN' and therefore, the said mark is a source indicator under Section 2(1)(za) of the Act and is not a product indicator at all.

7.8. On account of its long usage, credibility, popularity and wide publicity in the market, learned counsel contends that the mark 'D-TAN' has acquired exclusivity in relation only to the respondent no.1 and has thus, acquired a secondary meaning in the minds of the public. He would urge that in such circumstances, the Court must be loath to interfere in such matters particularly when the said mark has been in continuous and extensive use from the last fifteen years. He relied upon the judgment in ***Godfrey Philip India Ltd. vs. Girnar Food & Beverages Pvt. Ltd***., ***2004 (5) SCC 257*** particularly para 4.

7.9. Learned counsel next contended that the petitioner has not approached this Court with clean hands and has deliberately suppressed material facts. He would submit that the petitioner himself has filed a trademark application no.5919882 dated 02.05.2023 seeking registration of the mark

'AQUALOGICA DETAN + DEWY SUNSCREEN' which has been filed without any limitation or disclaimer and claims a recent use of 03.03.2023. Learned counsel would vehemently contend that having rights in the said mark including the mark 'D-TAN', it is not within the competence of the petitioner to now state that the term 'D-TAN' is either generic, or descriptive, or even common to trade. Petitioner cannot be permitted to approbate and reprobate. In support of the said contentions, learned counsel relies on ***Automatic Electric Ltd. vs. R.K. Dhawan & Anr.; 1999 (77) DLT 292***, para 14-16 and 19; ***Indian Hotel Company Ltd. vs. Giva Institute of Vedic Science & Culture, 2008 (37) PTC 468 (Del)*** and ***Zydus Wellness Products Ltd. vs. Cipla Health Ltd., 2023 SCC OnLine Del 3785*** at para 205.

7.10. Mr. Vutts, learned counsel would also submit that the falsity of the petitioner's claim can be ascertained from the reply dated 05.05.2023 issued by the petitioner to the cease and desist notice sent by the respondent no.1 wherein, the petitioner has categorically stated that it has not applied for any trademark containing the mark 'D-TAN'. Whereas, the petitioner by that time on 02.05.2023 had already applied for registration of the mark 'AQUALOGICA DETAN + DEWY SUNSCREEN'. Thus, on the said contention, learned counsel would submit that the petitioner having approached this Court with unclean hands and false assertions, cannot be entertained and the petition ought to be dismissed.

7.11. In any case, learned counsel would contend that the sales turnover of all the products of the petitioner even when calculated from the year 2021 is about Rs.31 Crores only, while the respondent no.1's extends back to the year 2009 and for one year itself the sales turnover for the brand 'D-TAN' alone

has crossed Rs.50 Crores. He would contend that in case the petitioner is claiming on such sales turnover of all its products brought together, as a well-known trademark, by that logic the petitioner's mark 'D-TAN' too, be declared as a well-known trademark and can fall within the category of a distinctive mark.

7.12. Predicated on the aforesaid arguments, learned counsel would contend that the petition is bereft of any merits and ought to be dismissed with costs.

REJOINDER ON BEHALF OF THE PETITIONER:-

8. Mr. Bhandari, learned senior counsel, to the argument that the word 'D-TAN' is a coined word and a distinctive mark having no meaning in English language, contends that the word '*De'* as per the Oxford Dictionary universally recognizes the said word to denote the removal, reversal or deduction of an action. Coupled with that, the word '*Tan*' is defined as (i) a yellowish-brown colour and (ii) a golden brown-shade of skin developed by pale skinned people after being in the sun. He contended that both the words combine together only convey the removal or reversal of the tanning of the skin which occurs due to exposure to the sun. According to him, it requires no mental leap or imagination by the ordinary prudent consumer to understand the nature and the kind of goods that are being offered when a manufacturer uses the mark 'D-TAN'.

8.1. Learned senior counsel emphasized that respondent no.1 itself uses the word 'D-TAN' alongwith functional classifications like *hydrate, glow, clear* and *radiance.* Thus, according to him, the mark of respondent no.1 is neither coined word nor distinctive but a mere descriptor.

8.2. Contrary to the argument of respondent no.1 that petitioner is using 'DETAN' as their sub-brand. Learned senior counsel would submit that the petitioner is not using 'D-TAN' or 'DETAN' as a trade mark or an independent proprietary sub-brand. It is stated that the mark is employed strictly as a secondary, descriptive modifier to explain the functional characteristics etc., and intended purpose of the product. Even visually, according to the learned senior counsel, the text 'DETAN' appears as an explanatory descriptor modifier alone. Learned senior counsel quotes a number of market leaders who too use the mark 'DETAN' or 'D-TAN' right after the brand name to denote the use of the product. Thus, there is no question of the mark 'DETAN' being used as a sub-brand.

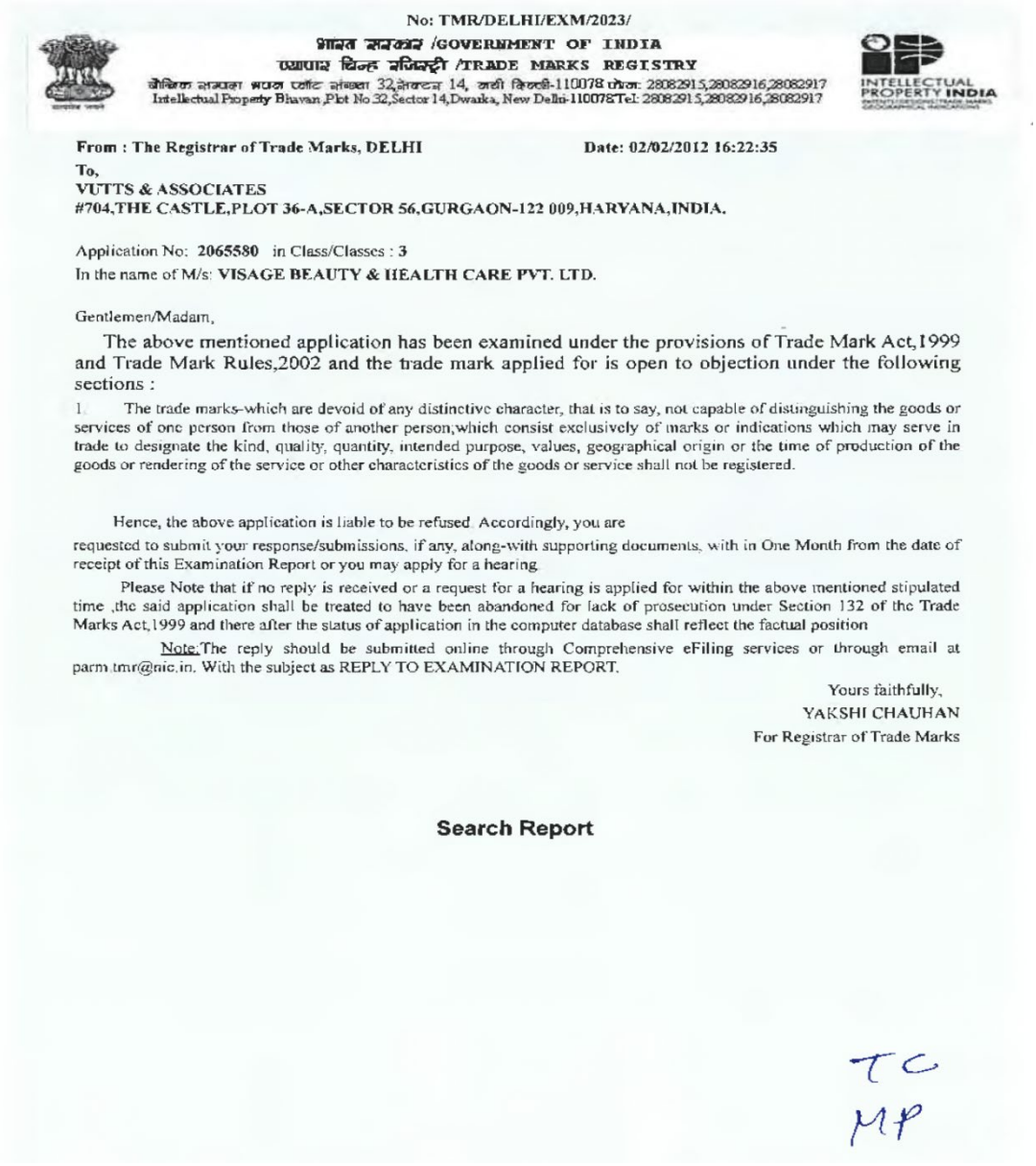
8.3. So far as the mark of the respondent no.1 having acquired either distinctiveness or secondary meaning on account of continuous use and massive financial turnover is concerned, learned senior counsel relied upon the judgment of ***Delhivery Pvt. Ltd.*** (*supra*) to submit that the financial turnovers would simply show commercial growth of business and do not transition a descriptive term into a distinctive word. Thus, as per learned senior counsel, the mark 'D-TAN' wrongly remains on the Register of Trade Marks or trademarks and ought to be removed.

ANALYSIS AND CONCLUSION:-

9. Before adverting to the other aspects of the dispute at hand, it appears significant to appreciate as to under what circumstances the respondent no.1 got its mark 'D-TAN' registered in the year 2010. It is relevant to note that respondent no.1 applied for registration of its mark 'D-TAN' on 09.12.2010

claiming user since 01.12.2009 in respect of manufacture of cosmetic products under Class-3.

10. The Trade Mark Registry (hereinafter referred to as "*TMR*") raised an objection under Section 9(1)(a) and 9(1)(b) of the Act on 02.02.2012. It would be relevant to extract the said objection hereunder:



No: TMR/DELHI/EXM/2023/

भारत सरकार /GOVERNMENT OF INDIA

व्यापार चिन्ह रजिस्ट्री /TRADE MARKS REGISTRY

बौद्धिक सम्पदा भवन प्लॉट संख्या 32,सेक्टर 14, द्वारका दिल्ली-110078 दूरभाष: 28082915,28082916,28082917

Intellectual Property Bhavan ,Plot No 32,Sector 14,Dwarka, New Delhi-110078Tel: 28082915,28082916,28082917

INTELLECTUAL PROPERTY INDIA

From : The Registrar of Trade Marks, DELHI **Date: 02/02/2012 16:22:35**

To,
VUTTS & ASSOCIATES
#704,THE CASTLE,PLOT 36-A,SECTOR 56,GURGAON-122 009,HARYANA,INDIA.

Application No: **2065580** in Class/Classes : **3**
In the name of M/s: **VISAGE BEAUTY & HEALTH CARE PVT. LTD.**

Gentlemen/Madam,

The above mentioned application has been examined under the provisions of Trade Mark Act,1999 and Trade Mark Rules,2002 and the trade mark applied for is open to objection under the following sections :

1. The trade marks-which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service shall not be registered.

Hence, the above application is liable to be refused. Accordingly, you are requested to submit your response/submissions, if any, along-with supporting documents, with in One Month from the date of receipt of this Examination Report or you may apply for a hearing.

Please Note that if no reply is received or a request for a hearing is applied for within the above mentioned stipulated time ,the said application shall be treated to have been abandoned for lack of prosecution under Section 132 of the Trade Marks Act,1999 and there after the status of application in the computer database shall reflect the factual position

Note:The reply should be submitted online through Comprehensive eFiling services or through email at parm.tmr@nic.in. With the subject as REPLY TO EXAMINATION REPORT.

Yours faithfully,
YAKSHI CHAUHAN
For Registrar of Trade Marks

Search Report

TC
MP

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY

INTELLECTUAL PROPERTY INDIA

LOCATION:
SECTION: EXM
REPORT: EXM007

WORD MARK SEARCH REPORT
APPLICATION NUMBER: 2065580
Class : ---
TRADEMARK: 'D-TAN'

USER : YKC
PAGE:1
DATE: 13/09/2011

APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE
GOODS SERVICES							

YAKSHI CHAUHAN
For REGISTRAR OF TRADE MARKS

Exit Print

11. It is clear from the reading of the objection that the TMR found the mark applied for, devoid of any distinctive character, covered by Section 9(1)(a) of the Act and that it consists exclusively of marks or indications which may serve the trade to designate the kind, quality, quantity, intended purposes etc. It is interesting to note the reply dated 30.09.2014 submitted by respondent no.1 in response to the objection dated 02.02.2012. Before analysing and examining the response, it would be appropriate to extract the reply dated 30.09.2014 hereunder:-

Legal Solutions

Trade Mark, Copyright, Design & Patent Attorneys

September 30' 2014

THE REGISTRAR OF TRADE MARKS
The Trade Marks Registry,
New Delhi - 110075

Re: Application no. 2065580 in class 3 for mark 'D-TAN'

Sir,

Reference is made to examiner report dated 13.09.2011 in respect of the above application, we request you to allow us to make the following submissions for your consideration and acceptance of the mark:

As regards to objection under Section 9 of the act, the same is not maintainable as the applicant's label mark does not designate the kind, quality, intended purpose, values, geographical origin or the time of production of the goods therefore the question of distinctiveness does not arise. The mark is represented in a particular label with logo bearing a distinctive artistic work, style and representation and the same as such is distinctive of the goods.

That the applicant has been using the mark since inception in respect of the claimed goods and services and till date there is no objection from anyone in the market or trade.

The applicant further like to bring it to the Hon'ble Registrar's attention that as per the provision of Section 12 of the Trade Marks Act 1999, an application can be registered on

TC
MP

F – 8 & 9, 1st Floor, Ansal Tower, Plot No. 4 & 5, Commercial Complex,
A-2 Block, Paschim Vihar, New Delhi – 110063
e-mail: consult.ipr@gmail.com

Trade Marks Registry
Dy. No. 67685
Date 30/9/2014

the basis of the honest concurrent use of the mark, which happens to be the applicant in this case.

The applicant reserves the right to amend this reply or file further documents in support of the claim in the mark.

In case on any further clarification, you are requested to grand a hearing to the applicant.

On the basis of our plea in the matter, we move with confidence that your honor will accept the mark and will order for publication in the Trade marks Journal.

Enclosed: as stated

Thanking You

Yours Faithfully

For LEGAL SOLUTIONS

12. What comes to fore is the complete absence of any response to the objection under Section 9(1)(a) of the Act regarding the mark applied for being devoid of any distinctive character. Meaning thereby, that respondent no.1 did not have any answer to the objection of the mark not having any distinctive character. This aspect becomes clearer while examining the said response further. Before this Court alludes to the other relevant aspect, it is also significant to note the response to the objection under Section 9(1)(b) of

the Act. Other than to simply deny that the mark does not designate any of the ingredients of Section 9(1)(b) of the Act, there is no substantive explanation or reason to overcome the said objection. In a weak manner, the respondent no.1 claimed that the said mark "*is represented in a particular label with logo bearing a distinctive artistic work, style and representation and the same as such is distinctive of the goods*". Firstly, the mark 'D-TAN' is a word mark thus, the question of it being distinctive merely being represented in a label with a logo bearing distinctive artistic work, style, etc. does not arise; and secondly, no such logo or label has either been demonstrated or placed on record to show "*distinctiveness*". Thus, in the opinion of this Court, respondent no.1 has been unable to provide any satisfactory justification or explanation to overcome either the objection under Sections 9(1)(a) or 9(1)(b) of the Act.

13. In continuation of the aforesaid, respondent no.1 in its reply dated 30.09.2014 had squarely relied upon the provisions of Section 12 of the Act to contend that an application seeking registration of a mark on the basis of honest concurrent use is permissible. Though, no doubt that while registering the mark 'D-TAN' in favour of respondent no.1, the respondent no.2/Registrar of Trade Marks did not place any conditions or disclaimer, however, the reliance of respondent no.1 on Section 12 of the Act may be an "*Achilles heel*" to its case. What could be various circumstances under which registration under Section 12 of the Act can be permitted, has to be gathered from the language itself. Section 12 of the Act is therefore reproduced hereunder:-

"Section 12. Registration in the case of honest concurrent use, etc.

In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose."

14. It appears from a plain and harmonious reading of the provisions of Section 12 of the Act that in case of an honest concurrent use of a particular mark by a proprietor, the Registrar of Trade Marks may permit the registration of the said mark by more than one proprietor of the said mark which is identical or similar in respect of the same or similar goods or services, subject to conditions and/or limitations. It is relevant to note that identical or similar marks may be registered by more than one proprietor even when "*any such trade mark is already registered or not*". In the opinion of this Court Section 12 of the Act appears to be an exception to the absolute grounds of refusal under Section 9 and relative grounds of refusal of registration under Section 11 of the Act. The legislature in its wisdom seems to have carved out this exception bearing in mind "*honest concurrent use or of other special circumstances*" to be considered by the Registrar of Trade Marks.

15. The fallout of reliance on Section 12 of the Act by any "*honest concurrent user*", in view of the aforesaid opinion, would surely imply that the registrant under Section 12 of the Act may not have any reason to object to any other person or entity from using similar or identical marks in respect of same or similar goods or services. This is for the reason that the said entity itself has obtained registration on a demurrer that there could be other

registrants or users of same or identical marks in respect of same or similar goods or services. The subsequent registrant, of course, may be bound by conditions and limitations, if any, imposed by the Registrar of Trade Marks. However, it is pertinent to note that in the present case, the petitioner has not sought registration of the mark 'DETAN' separately or independently but has sought registration only of its mark 'AQUALOGICA'. In fact, unreservedly, the petitioner contends and admits that the word 'DETAN' is purely descriptive of its goods and, therefore, it also contends that respondent no.1 possibly cannot have any objection to its use of the mark 'DETAN' alongwith its registered trademark 'AQUALOGICA'.

16. Thus, bearing in mind the lack of justification or explanation to the objections under Section 9(1)(a) and flimsy and unacceptable explanation to those under Section 9(1)(b) of the Act, this Court is of the considered opinion that the respondent no.1 could not have got its mark 'D-TAN' registered under the Act.

17. The other contention in respect of the mark 'D-TAN' is in the context of the same being descriptive and not distinctive. Learned counsel for respondent no.1 had contended that the mark 'D-TAN' is unique, easy to remember, catchy and has no meaning ascribed to it in the English language dictionary. He had also contended that at the time when the mark 'D-TAN' was coined and adopted no other entity or manufacturer had adopted or used the said mark. Learned counsel also had argued that the said mark was being regularly, extensively, openly and continuously being used for the manufacture of its products for the last more than 15 years and has garnered immense goodwill and tremendous reputation. On the said basis, learned

counsel also argued that the said mark has gathered secondary significance. Thus, according to him, the said mark cannot be removed from the Register of Trade Marks.

18. In the aforesaid context, learned senior counsel for the petitioner had referred to the Oxford Dictionary, the relevant screenshots of respondent no.1's own website and the screenshots of other manufacturers in the same trade to contend that the word 'D-TAN' is purely descriptive of the product and its intended purpose.

19. This Court would initially examine the meaning attached to the words 'de' and 'tan' in the Eleventh Edition of the Oxford Dictionary. According to the said dictionary the word 'de' connotes "*prefix forming or adding to verbs of the derivatives, 1. Down: deduct, 2. Completely: denude, 3. Indicating removal or reversal: de-ice"*. Apart from above, there are numerous such words like deregister, demote, delink, deficiency, defect, decrease, demerit, delete, demise, deprivation etc., which would clearly demonstrate removal or reversal of the previous condition or an act etc. The word 'tan', according to the said dictionary, is defined as "*Noun. 1. A yellowish-brown colour, 2. A golden brown-shade of skin developed by pale-skinned people after being in the sun.*".

20. Combining both the words 'de' and 'tan' together would clearly demonstrate removal or reversal of tanned condition of the skin. This has to be considered bearing in mind that the products manufactured by both the parties are cosmetics falling in Class-3 in relation to skincare products. Clearly, in the context of such products, the word 'DETAN' or for that matter 'D-TAN' would undoubtedly imply a product which, when used, may bring about

removal or reversal of the tanning of the skin. Thus, the words 'D-TAN' or 'DETAN' would be nothing other than a pure description of the goods manufactured by both the parties.

21. In order to evidence and corroborate the above analysis based on the dictionary meaning and to understand and appreciate how the stakeholders in the cosmetic industry too consider the words 'D-TAN' or 'DETAN' as a descriptor, it is found necessary to extract hereunder screenshots of the products of not only the respondent no.1 but also the petitioner and other such manufacturers in the cosmetic industry:-

Photographs of Product Packaging of the Petitioner

Detan+ Dewy Sunscreen

Detan+ Smoothie Face Wash

Detan+ Dewy Sunscreen

Photographs of Product Packaging of the Respondent No. 1

Blueberry Dtan Tan Removal for Face & Body

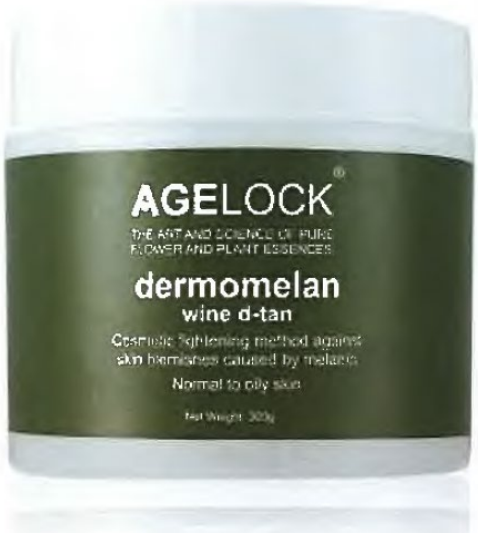
Cranberry D Tan For Tan Removal

O3+ Oxy D-Tan Mask

Dtan Pack

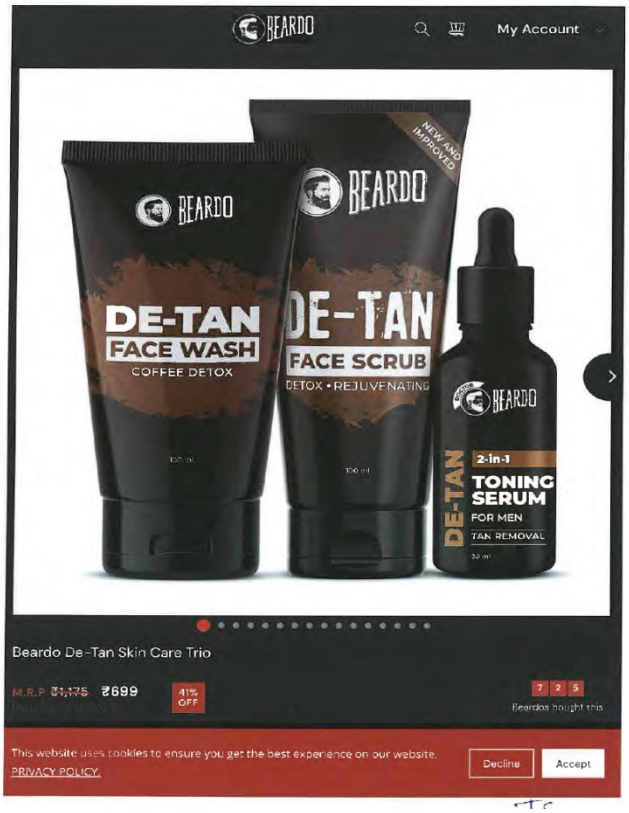
O3+ D-Tan Facial kit with Peel off Mask

Agelock Dermomelan Wine D-Tan

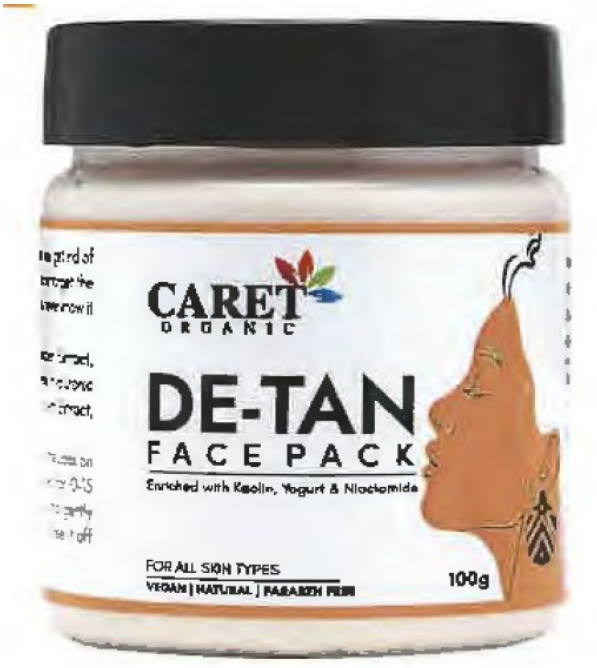


ALPHA MEN Acno D-TAN Face Wash with Tea Tree

T6



T6



22. Apart from the above, it would be relevant to also note paras 11.16 and 11.69 of 'McArthy on Trademarks and Unfair Competition'. According to the learned author the hierarchy of the protection to be received by various marks are described as under:-

"11.16 What is a "descriptive mark"?

Types of Description. *A "descriptive" term is one that directly and immediately conveys some knowledge of the characteristics of a product or service.*

A mark is "descriptive" if it is descriptive of:

- *the intended purpose, function or use of the goods.*
- *the size of the goods.*
- *the provider of the goods or services.*
- *the class of users of the goods or services. Thus, the term PHILADELPHIA CARD was found to be descriptive of credit card services for cards depicting Philadelphia targeting customers in Philadelphia.*
- *a desirable characteristics of the goods or services. Thus, the term OATNUT for bread immediately tells that the bread contains oats and nuts. The word ERGONOMIC immediately informs potential buyers of a ceiling fan that the fan is designed to interact efficiently and safely with the user.*
- *a desirable ingredient in the goods.*
- *the sound made by an important feature of the goods.*
- *the nature of the goods or services. Thus, the term E-FASHION immediately and directly says that the Internet service provides information about fashions.*
- *the end effect upon the user.*
- *a common serving size or unit of measurement in which the product is sold.*

Descriptive of Some of the Goods or Services or Some of Their Aspects. *That the term asserted to be non-descriptive may not be descriptive of all of the goods or services with which it is used does not mean that it is not "merely descriptive." A term is "descriptive" if it directly describes any of the goods or services with which it is used. Similarly, a term that describes some, but not all, of the aspects of the goods or services is still*

"descriptive." To be found "descriptive," a term need only describe a single, significant quality or feature of the goods or services."

Retail Sales Services. *A term can be descriptive of retail sales services if it is the generic name of a product sold at that outlet. For example, a mark for restaurant services which comprises the generic name of a food that is the speciality of the house can be merely descriptive of restau-rant services, be it in English or in a foreign language. LE CROISSANT SHOP was held descriptive of restaurant services, since prospective customers would immediately know that croissants could be purchased. Similarly, the word PENCILS was held to be descriptive of "retail stationery and office supply services" because it describes an item that is sold in stationery and office supply stores even though it is not the main item sold in such stores.*

Evaluate the Term in Relation to These Goods and Services. *Descriptiveness cannot be determined as an abstraction. The possible descriptiveness of a designation is highly dependent on the goods or services in connection with which the designation is used. A term can be descriptive of one product and nondescriptive of another. As the Trademark Board observed:*

§11:69 Tests for determining descriptive- suggestive distinction-Use by competitors, the media and dictionaries

Descriptive Use by the Proponent and Others. *A use-ful way to test whether a designation is descriptive or suggestive is to determine the extent to which other sellers have used the designation on similar goods and services. If others are in fact using the term to describe their goods or services, an inference of descriptiveness can be drawn. For example, in finding QUIK-PRINT to be descriptive of copying and printing services, the Trademark Board said that: "[T]he widespread use of the term "QUIK-PRINT" throughout the United States by others…….tends to establish that the term has lost whatever suggestiveness it may have possessed and has taken on and projects a descriptive significance of quick or fast printing services to the general public. Proliferation of use of a term can often lead to a diminution of its ability to identify and distinguish the services or goods of any one user thereof." Extensive descriptive use indicates that both sellers and buyers view the designation as descriptive:*

> *In determining whether a word or syllable has a descriptive or suggestive significance as applied to merchandise it is proper to take*

notice of the extent to which it has been used in trademarks by others on such merchandise. If it has been frequently so used, the inference is warranted that it is not purely arbitrary; that it would be likely to be understood by purchasers as identifying or describing the merchandise itself, rather than the source thereof and hence as having little or no trademark significance."

On the other hand, if both plaintiff and defendant use the same term but in connection with two very different kinds of goods or services, this tends to negate the claim that the term is merely descriptive.

It is also relevant that the proponent of trademark status itself used the term in a descriptive sense. After the designa-tion has been found descriptive, evidence of extensive third party use can prevent a finding of secondary meaning.

Third Party Registrations. *Third-party registrations are probative evidence of the meaning of a word, in the same way that a dictionary can be used. Similarly, third-party registrations of composite marks including an allegedly descriptive term can be used to help prove the descriptive nature of that term. For example, introduction of many third-party registrations for electronic products of marks with a -TRONICS or -TRONIX suffix could be evidence that those third parties and the public consider such a suffix descrip-tive, such that there would be no likely confusion between DAKTRONICS and TEKTRONIX.*

However, third party mark registrations may in some cases support the argument that a designation is not descriptive. The fact that the U.S.P.T.O. registered a number of marks containing the same designation without requiring proof of secondary meaning is some evidence that the PTO considers the designation not descriptive.

Trade Publications. *Articles from trade publications evidencing use by others of the term in a descriptive manner are competent to prove descriptiveness and are not hearsay because they are not introduced to prove the truth of the statements, but only that they were made.*

Dictionaries. *The Trademark Board will take judicial no-tice of a dictionary definition to help determine if a term has an accepted descriptive meaning." However, the fact that a certain word does not appear in any*

dictionary is not determinative if other evidence shows that the word clearly conveys a descriptive meaning.

But dictionary definitions can help shed light on whether a designation is likely to be perceived as directly descriptive of the goods or services. As the Seventh Circuit remarked: "[T]here is no prohibition on using dictionaries as a piece of the puzzle."

23. A cumulative reading of paras 11.16 and 11.69 of McArthy provides guiding principles for determination of whether a mark is descriptive or otherwise. One of the tests which has been laid down by McArthy is to examine and apply to the facts of a particular case as to how the entire industry is using the said mark. In the present case, if one were to apply the said test, manifestly the marks 'D-TAN' or 'DETAN' are nothing but pure descriptors of the kind, quality and intended purpose of the products manufactured falling strictly within Section 9(1)(b) of the Act. Thus, even on this aspect the mark 'D-TAN' appears to be a descriptive word and not distinctive. [See ***Renee Cosmetics Private Limited vs. Ms. Rupali Sharma & Anr.***, in ***C.O. (COMM.IPD-TM) 107/2025***, decision dated 05.06.2026]

24. Additionally, the mark 'D-TAN' conveys the nature, kind and intended purpose of the goods which too is opined to be descriptive as per McArthy.

25. Notwithstanding the fact that the respondent no.1 had not furnished and explanation or justification to the objection of the TMR under Section 9(1)(a) of the Act, this Court also finds, particularly in view of the aforesaid analysis, that the mark of respondent no.1 is not capable of distinguishing the goods or services of one person from those of another. Therefore, not only is the mark 'D-TAN' of respondent no.1 descriptive but also appears to be common to trade.

26. The aforesaid screenshots, particularly of the products of respondent no.1 indicate that respondent no.1 itself uses the words 'Professional O3+' prominently on its products and the mark 'D-TAN' in a small font at the lower end of the product, usually with prefixes like 'BLUEBERRY', 'CRANBERRY' and 'OXY' indicating the nature of the product. This particular usage of the mark 'D-TAN' of respondent no.1 with aforesaid prefixes also impels this Court to draw the conclusion that the respondent no.1 itself uses the said mark more in the nature of a description of the goods rather than a trademark.

27. Great emphasis was laid by the learned counsel for respondent no.1 on the substantial goodwill and immense reputation garnered by the mark 'D-TAN' over the last 15 years and as to how it has gathered secondary significance leading the said mark to be distinctive. Though respondent no.1 has placed on record sales figures and revenue generation of the last 15 years garnered by the mark 'D-TAN' in the form of certificates issued by the CA, however, that by itself may not necessarily imply secondary significance. It is trite that a generic or a descriptive mark may receive statutory protection provided that long usage of such mark has gathered secondary significance. However, in the present case respondent no.1 has not placed on record anything other than the CA certificates to establish its case in the context of secondary significance. While the CA certificates, *prima facie* establish, commercial success of respondent no.1's products, the same do not, and cannot, in the facts of the present case connote, corroborate or establish as a fact that the mark 'D-TAN' of respondent no.1 has been imprinted in the minds of the general consumer indelibly in such manner that when the mark

'D-TAN' of respondent no.1 is recollected by the general public, it is the goods of respondent no.1 and respondent no.1 alone that come to the mind of the general public. No such document or any such evidence has been placed on record, in the absence whereof, this Court is unable to accede to the argument that the mark 'D-TAN' has gathered secondary significance to be granted any protection as sought.

28. So far as the objection regarding maintainability of the present petition under Section 57 of the Act is concerned, the petitioner would clearly fall within the meaning of "*an aggrieved person*" occurring in the said section. This is for the reason that by virtue of cease and desist notice dated 14.04.2023 issued by the respondent no.1, it was demanded that the petitioner refrain from using the mark 'D-TAN/DETAN' on its products which according to the petitioner is a descriptive mark and not registrable under the Act. Having regard to the aforesaid analysis and the conclusion that the mark 'D-TAN' is descriptive, the restriction or prohibition sought by respondent no.1 to the use of the mark 'DETAN' by the petitioner, would be restrictive of petitioner's lawful trade, constituting an act by virtue whereof the petitioner would be "*an aggrieved person*" [See - ***Hardie Trading Ltd.*** *(supra)* para 32]. Therefore, the present petition instituted by the petitioner is maintainable under Section 57 of the Act.

29. In view of the aforesaid analysis and conclusions reached by this Court, it appears that an order under Section 57(2) of the Act against the registered trade mark 'D-TAN' of respondent no.1 is made out.

30. Since, the aforesaid analysis are purely fact based, and on the basis of the material on record, the ratios laid down by the judgments relied upon by

the parties, in the context of legal interpretations may not be required to be gone into, and are therefore, not referred to.

31. *Ergo*, the petition is allowed and the respondent no.2/Registrar of Trade Marks is directed to cancel the registration of the mark 'D-TAN granted in favour of respondent no.1 bearing application no.2065580 registered on 30.01.2018 under Class-3. The Registrar of Trade Marks is further directed to remove/rectify the registration of the mark 'D-TAN' granted in favour of respondent no.1 *vide* bearing application no.2065580 on 30.01.2018 under Class-3 from the Register of Trade Marks within four weeks from date of receipt of this Order.

32. No order as to costs.

33. The petition alongwith pending applications, if any, stand disposed of in above terms.

TUSHAR RAO GEDELA
(JUDGE)

JUNE 19, 2026*/yrj/rl*